



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,933	06/22/2001	Robert Patrick Hof	24615201XX00	7691

25225 7590 07/09/2002

MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

EXAMINER

KUMAR, SHAILENDRA

ART UNIT	PAPER NUMBER
----------	--------------

1621

DATE MAILED: 07/09/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/887,933

Applicant(s)
Hof et al

Examiner
Shailendra Kumar

Art Unit
1621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 29, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 and 5 6) ☐ Other:

Art Unit: 1621

DETAILED ACTION

This office action is in response to applicants' communication filed in paper # 8, on 4/29/02.

Claims 12-22 are pending in this application.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed 3/5/02 and 3/29/02 complies with 37 CFR 1.98(a)(3) and has been placed in the application file, and the information referred to therein has been considered.

Rejection of claims 12-22 under 35 U.S.C. 102(b) over Hijiya et al is hereby withdrawn subsequent to applicants' amendment.

Claim Rejections - 35 U.S.C. § 103

3. Claims 12-22 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Hijiya et al, for the reasons of record as set forth in paper # 3.

Art Unit: 1621

Instant claims are directed to a process of racemizing an enantiomer enriched Schiff base of a primary amide of an amino acid by contacting said enantiomer -enriched Schiff base with a strong base in an organic solvent, wherein the organic base is chemically reactive with water.

Applicants' arguments were fully considered and were not found convincing. Applicants argue that Hijiya is directed to a different problem than claimed herein. But at the same time applicants admit that racemization will occur. Applicants further allege that the contribution of the invention is to use bases which are reactive with water, which problem is not even alluded in the reference. But then applicants admit that the reference indeed uses base that is reactive with water. In this regard, the examiner would like applicants to see examples 6 and 7, wherein sodium methoxide has been used as base. Finally, applicants allege that, whatever Hijiya is doing, it is proceeding in a different fashion from the process of the instant claimed process. Applicants also allege that they are using catalytic amount of the base as against 0.1-0.5 equivalent of the base in the reference. The examiner disagrees. See the examples in herein, and compare with examples 6-7, the amount appears to be similar.

In summary, the reference does suggest the present invention, because it refers to racemization of an amide(may not be primary amide), does use the base that is reactive with water, uses similar amount of base, and mechanism is irrelevant inasmuch as the process is similar, and hence the process is prima facie obvious as a whole, absent evidence to the contrary.

No claim is allowed.

Art Unit: 1621

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703)-308-4519. The examiner can normally be reached on Monday to Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703)-308-4556.

Application/Control Number: 09/887,933

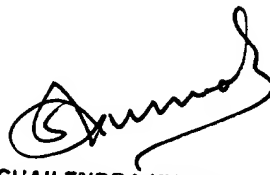
Page 5

Art Unit: 1621

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1235.

S.Kumar

7/4/02



SHAIENDRA KUMAR
PRIMARY EXAMINER
GROUP 1200